

**REMARKS**

Claims 31-84 are pending in this application. Claims 36 – 39, 45 – 58, and 60 – 66 have been withdrawn as directed to nonelected subject matter. Claims 1 – 30 and 67 – 83 have been canceled without prejudice or disclaimer to the subject matter contained therein. Applicants reserve the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing or divisional application. No new matter has been added within the meaning of 35 USC § 132. Therefore, entry of the amendments is respectfully requested.

Claim 31 recites: “A method of cosmetic care for obtaining a slimming effect on the human body, comprising the topical delivery on the part or parts of the body presenting subcutaneous fat and in need of said slimming effect of a slimming effective amount of at least one phytosphingosine compound selected from the group consisting of phytosphingosine, its cosmetically acceptable salts and mixtures thereof.”

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

**REJECTIONS UNDER 35 U.S.C. §103(a)**

By way of introduction, Applicants submit that none of the cited references, individually or in combination, suggests that phytosphingosine or its derivatives would have a slimming effect on the skin. Likewise, the references, in any combination, do not provide any suggestion or motivation to modify their teachings to arrive at the claimed subject matter. Hence, the cited references provide no reasonable expectation of success. Applicants likewise submit that the combination of phytosphingosine or its derivative with other active agents known for their lipolytic activities to create a synergistic is not taught in the prior art. Specifically, the synergy is directly related to the fact phytosphingosine acts by complimentary mechanism on the synthesis of leptin.

Despite the generic teachings of the cited references, the specific bases of the rejections is made using an a posteriori knowledge of the art presented in the teachings of the instant application.

**Jackson, et al. in view of Bombardelli, et al.**

The Examiner has rejected claims 67, 69 and 74-76 under 35 U.S.C. §103(a) as being obvious over Jackson, et al., U.S. Patent No. 5,578,641, and further in view of Bombardelli, et al., U.S. Patent No. 5,679,358.

Applicants traverse this rejection. Claims 67, 69 and 74 – 76 have been cancelled without prejudice or disclaimer to the subject matter contained therein, thereby rendering the basis for this rejection moot.

Accordingly, the Examiner is asked to withdraw this rejection to claims 67, 69 and 74-76.

**Jackson, et al. in view of Bombardelli, et al. further in view of Streekstra et al.**

The Examiner has rejected claim 68 under 35 U.S.C. §103(a) as being obvious over Jackson, et al., above, in view of Bombardelli, et al., above, and further in view of Streekstra, et al., WO 00/53568.

Applicants traverse this rejection. Claim 68 has been canceled without prejudice or disclaimer to the subject matter contained therein.

Accordingly, the Examiner is respectfully requested to withdraw this rejection to claim 68.

**Jackson, et al. in view of Bombardelli, et al. further in view of Andre et al.**

The Examiner has rejected claim 77 under 35 U.S.C. §103(a) as being obvious over Jackson, et al., above, in view of Bombardelli, et al., above, and further in view of Andre et al., U.S. Patent No. 5,709,864.

Applicants traverse this rejection. Claim 77 has been canceled without prejudice or disclaimer to the subject matter contained therein.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection to claim 77.

**Jackson, et al. in view of Andre et al.**

The Examiner has rejected claims 67, 69, 74 and 78-79 under 35 U.S.C. §103(a) as being obvious over Jackson, et al., above, in view of Andre et al., above.

Applicants traverse this rejection. Claims 67, 69, 74 and 78 – 79 have been canceled without prejudice or disclaimer to the subject matter contained therein.

Accordingly, the Examiner is asked to withdraw this rejection to claims 67, 69, 74, and 78 - 79.

**Bombardelli, et al. in view of Jackson, et al. and further in view of Pelletier, et al.**

The Examiner has rejected claims 31-32, 34-35, 40-42 and 84, under 35 U.S.C. §103(a) as being obvious over Bombardelli, et al., above, in view of Jackson, et al., above, and further in view of Pelletier, et al., U.S. Published Patent Application No. 2002/0042438.

Applicants traverse this rejection. There is no motivation to modify the combination of references in order to arrive at the claimed subject matter.

Regarding motivation to modify properly combined references, **MPEP 2143** states that where the prior art conflicts, all teachings must be considered and that the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. **MPEP 2143** further states that there must be some suggestion or motivation to modify the references, and there must be a reasonable expectation of success. In addition, the prior art reference or references when properly combined, must teach or suggest all the claim limitations.

**MPEP 2143.01** states that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. If it does, then there is no suggestion or motivation to make the proposed modification. Further, the proposed modification cannot change the principle operation of a reference.

The teachings of Bombardelli et al. have been outlined in the previous responses, and Applicants herein submit that Bombardelli et al. teaches compositions containing esculoside alone or in combination with an adenylate cyclase stimulator and/or phosphodiesterase inhibitors is useful for improving micro-circulation and chronic venous deficiency, such as cellulitis. Likewise, Bombardelli et al. teach that another consequence of the action of esculoside on micro-circulation is that it may be used to improve the early signs of skin aging.

The teachings of Jackson et al. also have been outlined in the previous responses, and Applicants herein submit that Jackson et al. relates to a composition for topical application to the skin comprising at least one ceramide pathway intermediate or precursor thereof. The presence of the ceramides precursor or pathway intermediate enables obtaining a higher level of ceramides in the stratum corneum, which leads to a number of advantages such as skin anti-aging effects. Because Jackson et al. does teach phytosphingosine as a ceramide precursor, Jackson et al. may be considered as teaching that phytosphingosine may be used in a cosmetic composition as a ceramide precursor and consequently as an anti-aging agent. As previously submitted, Jackson et al. does teach the use of phytosphingosine for the eradication or reversal of skin aging, removal of rough or dry skin, or improving the lost of elasticity and flexibility of the skin. However, Jackson et al. do not teach or suggest the use of phytosphingosine as a lipolytic agent.

The new secondary reference, Pelletier et al., relates teaches the use of specific products, i.e., ergothioneine and its derivatives as anti-glycation agents. Pelletier et al. further teach that the action of anti-glycation agents results in the prevention or treatment of the loss of skin tonicity. Specifically, the loss of tonicity resulting from skin aging is due to an action of the ergothioneine on the glycation of proteins in the dermis such as collagen. The anti-glycation agents are taught as useful in the treatment of cellulitis, which is associated with an orange peel appearance of the skin. As such, it is taught that ergothioneine and its derivatives, based on their anti-glycation action, can be used as having a slimming action. See, paragraph 0046.

One of skill in the art would clearly see, however, that products useful in anti-aging treatments have no relation to those which are useful as slimming agents. The references make no suggestion or motivation to make the proposed modification. Further, the proposed modification cannot change the principle operation of a reference, which in this instance is a slimming effect. Furthermore, the mechanisms leading to anti-aging, anti-wrinkle and slimming effects are all different. Thus references teaching to one effect would not generally draw the interest of the skilled artisan interested in another effect. Additionally, cellulitis is not always linked to a subcutaneous excess fat, the removal of which is a direct result of the method of the instant application.

Furthermore, the instant subject matter is directed to the use of phytosphingosine to increase the synthesis of leptine. This is only one of the very numerous mechanisms for obtaining a slimming effect. However, this specific mechanism is not taught or suggested by any of the cited references and specifically not by Pelletier et al., which is directed to a product which has a completely different mechanism of action, i.e., anti-glycation agent.

Therefore, the combination of the references does not provide a suggestion or motivation to make the proposed modification necessary to arrive at the instantly claimed subject matter.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Bombardelli, et al. in view of Jackson, et al. further in view of Pelletier et al and further in view of Streekstra et al.**

The Examiner has rejected claim 33 under 35 U.S.C. §103(a) as being obvious over Bombardelli, et al., above, in view of Jackson, et al., further in view of Pelletier et al., and further in view of Streekstra, et al., above.

Applicants traverse this rejection. There is no motivation to modify the combination of references in order to arrive at the claimed subject matter.

According to MPEP 2143, where the prior art conflicts, motivation to modify properly combined references all teachings must be considered and that the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. There must be some suggestion or motivation to modify the references, and there must be a reasonable expectation of success. In addition, the prior art reference or references when properly combined must teach or suggest all the claim limitations. A proposed modification cannot render the prior art unsatisfactory for its intended purpose. If it does, then there is no suggestion or motivation to make the proposed modification. Further, the proposed modification cannot change the principle operation of a reference.

The teachings of Bombardelli et al. have been outlined in the previous responses, and Applicants herein submit that Bombardelli et al. teaches compositions containing esculoside alone or in combination with an adenylate cyclase stimulator and/or phosphodiesterase inhibitors is useful for improving micro-circulation and chronic venous deficiency, such as cellulitis. Likewise, Bombardelli et al. teach that another consequence of the action of esculoside on micro-circulation is that it may be used to improve the early signs of skin aging.

The teachings of Jackson et al. also have been outlined in the previous responses, and Applicants herein submit that Jackson et al. relates to a composition for topical application to the skin comprising at least one ceramide pathway intermediate or precursor thereof. The presence of the ceramides precursor or pathway intermediate enables obtaining a higher level of ceramides in the stratum corneum, which leads to a number of advantages such as skin anti-aging effects. Because Jackson et al. does teach phytosphingosine as a ceramide precursor, Jackson et al. may be considered as teaching that phytosphingosine may be used in a cosmetic composition as a ceramide precursor and consequently as an anti-aging agent. As previously submitted, Jackson et al. does teach the use of phytosphingosine for the eradication or reversal of skin aging, removal of rough or dry skin, or improving the loss of elasticity and flexibility of the skin. However, Jackson et al. do not teach or suggest the use of phytosphingosine as a lipolytic agent.

The new secondary reference, Pelletier et al., relates teaches the use of specific products, i.e., ergothioneine and its derivatives as anti-glycation agents. Pelletier et al. further teach that the action of anti-glycation agents results in prevention or treatment of a loss of skin tonicity. Specifically, the loss of tonicity resulting from skin aging is due to an action of the ergothioneine on the glycation of proteins in the dermis such as collagen. The anti-glycation agents are taught as useful in the treatment of cellulitis, which is associated with an orange peel appearance of the skin. As such, it is taught that ergothioneine and its derivatives, based on their anti-glycation action, can be used as having a slimming action. See, paragraph 0046.

As previously submitted, Streekstra, et al. teach topical application of salts of sphingoid base derivatives in the treatment of conditions associated with dry skin, inflammation and/or microbial

activity, i.e., eczema, psoriasis, atopic dermatitis, acne, dandruff, mouth and/or lip infections, mycoses, various other skin infectious diseases or vaginal infections, as well as, wounds, burns, and overall normalization of skin flora. Specifically, Streekstra et al. disclose sphingoid base derivatives having an improved efficacy due to their increased solubility in water.

As submitted above, one of skill in the art would not find products useful in anti-aging treatments have any relation to those which are useful as slimming agents. The references make no suggestion or motivation to make the proposed modification. Further, the proposed modification cannot change the principle operation of a reference, which in this instance is a slimming effect. Furthermore, the mechanisms leading to anti-aging, anti-wrinkle and slimming effects are all different. Thus references teaching to one effect would not generally draw the interest of the skilled artisan interested in another effect. Additionally, cellulitis is not always linked to a subcutaneous excess fat, the removal of which is a direct result of the method of the instant application.

Furthermore, the instant subject matter is directed to the use of phytosphingosine as an agent to increase the synthesis of leptine, which is only one of the very numerous mechanisms for obtaining a slimming effect. This specific mechanism is not taught or suggested by any of the cited references and specifically not by Pelletier et al., which is directed to a product which has a completely different mechanism of action, i.e., anti-glycation agent.

Therefore, the combination of the references does not provide a suggestion or motivation to make the proposed modification necessary to arrive at the instantly claimed subject matter.

Furthermore, claims 43-44, which depend indirectly from claim 31, relate to methods of use of a composition wherein the adenylate cyclase enzyme activating agent is an extract of *Coleus forskohlii* or of *Tephrosia purpurea* and therefore does not change the patentability which is already obtained for claim 31.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.



**Bombardelli, et al. in view of Jackson, et al. further in view of Pelletier et al. and further in view of Andre et al.**

The Examiner has rejected claims 43-44 under 35 U.S.C. §103(a) as being obvious over Bombardelli, et al., in view of Jackson, et al., above, in view of Pelletier, et al. and further in view of Andre et al., all above.

Applicants traverse this rejection. There is no motivation to modify the combination of references in order to arrive at the claimed subject matter.

Each of the cited references has already been discussed.

As previously submitted, Andre, et al. teach a cosmetic or pharmaceutical dermatological composition comprising an effective quantity of a plant extract of the genus Tephrosia, i.e., T. purpurea, which are used for anti-aging applications.

Furthermore, claims 43-44, which depend indirectly from claim 31, relate to methods of use of a composition wherein the adenylate cyclase enzyme activating agent is an extract of Coleus forskohlii or of Tephrosia purpurea and therefore does not change the patentability which is already obtained for claim 31.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

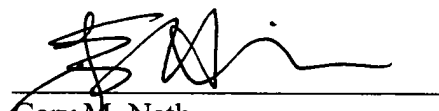
**CONCLUSION**

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

Respectfully submitted,  
**THE NATH LAW GROUP**

Date: March 13, 2009

A handwritten signature in black ink, appearing to read "G. Nath", is written over a horizontal line.

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